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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,245	09/08/2000	Lester D. Nelson	EXPL-01028US0 MCF/KJD	3031
23910	7590	10/30/2006	EXAMINER	
FLIESLER MEYER, LLP FOUR EMBARCADERO CENTER SUITE 400 SAN FRANCISCO, CA 94111			PATEL, HEMANT SHANTILAL	
			ART UNIT	PAPER NUMBER
			2614	

DATE MAILED: 10/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/658,245	Applicant(s) NELSON ET AL.	
	Examiner Hemant Patel	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 10-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 10-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Applicant Response dated August 17, 2006 to an Office Action dated March 21, 2006 is entered. Claims 1-4, 10-15 are pending in this application.

Response to Arguments

2. Applicant's arguments filed August 17, 2006 have been fully considered but they are not persuasive.

3. Regarding claim 1, the Applicant argues (Remarks, Pg. 7, ll. 10-11) "Wolff neither teaches nor discloses "dynamic interactive use" in the sense contemplated by the claims in the present application, Wolff does not anticipate claim 1". The Examiner respectfully disagrees. Wolff clearly teaches that called user at second device provides conversation responses to directly interact with caller (Wolff, col. 6, ll. 37-45). Further, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., specific dynamic interactive use in the sense contemplated by the claims in the application) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Response to Amendment

4. Applicant's arguments with respect to claims 1-4, 10-15 have been considered but are moot in view of the new ground(s) of rejection. The rejections are necessitated due to claim amendments.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-3, 10-12, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff (US Patent No. 5,327,486), and further in view of O'Kinneide (US Patent No. 6,138,036).

Regarding claim 1, Wolff teaches of a telecommunications infrastructure, comprising:

(a) a first electronic device (Fig. 1, item 22, calling telephone), coupled to the telecommunications infrastructure;

(b) a second electronic device (Fig. 1, item 18, used by called wireless party) coupled to the infrastructure, for providing conversation representation (Fig. 8);

(c) a processing device (Fig. 1, item 16, radio network), coupled to the telecommunication infrastructure and remote to the first device for storing 1) a conversation element (Fig. 8, 9; col. 6, ll. 38-39, predefined messages stored by PTM) associated with the conversation representation (Fig. 8) and 2) a software program for providing an audible utterance to the first electronic device in response to a selected conversation representation (col. 2, ll. 51-53), wherein the processing device can be invoked by a user of the stored conversation elements (Fig. 1, item 18) for dynamic interactive use with a second user (Fig. 1, item 22), and for text-to-speech conversion for real-time dynamic input with the second user (Fig. 9; col. 6, ll. 40; col. 5, ll. 1-6); and

(d) a recording device coupled to the second electronic device for audio recording into an utterance data store (col. 6, ll. 41-45).

(e) an audio input adapted to allow a user to voice directly into the second electronic device when appropriate (col. 7, ll. 15-22).

Wolff does not teach of switching to voice input mode and does not teach of telephone-to-user connection.

However, in the same field of endeavor, O'Cinneide teaches of a system wherein a personal computer (PC) (Fig. 1, item 300) is connected to external telephone (Fig. 1, item 200) through respective connectors (Fig. 1, items 285, 287) and switches to voice data mode (Col. 6, ll. 11-14), where user can use voice directly into it (col. 6, ll. 25-52) and this voice is transmitted as text to the network (col. 6, ll. 53-61) to be played to the user at the other end (col. 6, ll. 61-col. 7, ll. 8).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Wolff with telephone-to-user connection with a capability to switch between modes as taught by O'Cinneide in order to avoid "playback of sounds on a PC speaker" as it "is often socially inappropriate in many quiet or public environments" (O'Cinneide, col. 1, ll. 44-46).

Regarding claim 2, O'Cinneide further teaches of second electronic device generating an in-band signal (col. 6, ll. 53-56, transmitting through the PSTN).

Regarding claim 3, Wolff further teaches of the second electronic device generates an out-of-band signal in response to a conversation representation selection (Abstract, ll. 7-12).

Regarding claim 10, Wolff teaches of second device being mobile terminal. O'Cinneide teaches of both first (col. 6, ll. 25-30) and second terminal (col. 6, ll. 65-col. 7, ll. 2) being mobile telephones.

Regarding claim 11, O'Cinneide teaches of Internet Service Provider (col. 4, ll. 39-44).

Regarding claim 12, Wolff further teaches the radio network (processing device) acts as a relay between the calling wireless terminal and the called wireless terminal (see the claim 1 rejection for further details).

Regarding claims 14, Wolff further teaches of telecommunication infrastructure including wireless telephony application (Fig. 1, item 16).

8. Claims 2, 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff and O'Cinneide as applied to claim 1 above, and further in view of Swistock (US Patent No. 6,389,115 B1).

Regarding claims 2, 4, O'Cinneide teaches of second electronic device generating an in-band signal (col. 6, ll. 53-56, transmitting through the PSTN).

Wolff and O'Cinneide do not teach DTMF signaling.

However, in the same field of communication, Swistock teaches of using in-band signaling with DTMF (col. 1, ll. 37-38, playing DTMF signal).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Wolff and O'Cinneide to include the use of in-band signaling including DTMF as taught by Swistock in order to provide "an indication of a new message and the number of messages previously recorded in the system" (col. 1, ll. 38-40).

9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff and O'Cinneide as applied to claim 1 above, and further in view of Dowens (U.S. Patent No. 6,389,114 B1).

Regarding claim 13, Wolff and O'Cinneide do not teach of utterances during a conference call.

However, Dowens teaches of a relay device, where the relay of Dowens also relays the messages during a conference (abstract).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Wolff and O'Cinneide to add conferencing capability as taught by the relay device of Dowens.

The suggestion/motivation for doing so would have been to increase the flexibility and efficiency of the telephone communications system by allowing multiple participants to conference together during a single call instead of requiring each party to establish point to point calls when information is exchanged. In addition, such a modification would have conformed to telephone industry standard support for conferencing capability especially in a business environment.

10. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bremer (US Patent No. 6,018,671), and further in view of Brunet (US Patent No. 5,995,590).

Regarding claim 15, Makela teaches of a telecommunications infrastructure, comprising:

(a) a first electronic device (col. 2, ll. 9-14, remote device; col. 3, ll. 7-8, device used by caller to initiate call), coupled to the telecommunications infrastructure;

(b) a second electronic device (col. 2, ll. 9-14, remote device receiving a call) coupled to the infrastructure (Fig. 1, item 104, 150, 152), and remote to the first device for providing conversation representation, and for storing 1) a conversation element (col. 4, ll. 4-21, stored reply messages) associated with the conversation representation (col. 4, ll. 4-21, menu of choices) and 2) a software program for providing an audible utterance to the first electronic device in response to a selected conversation representation (col. 3, ll. 7-9, controller subroutine); wherein a processing device can be invoked by a user of the stored conversation elements (col. 3, ll. 10-13, user actuating silent answer key) for dynamic interactive use with a second user (col. 4, ll. 13-21, user selecting a message);

(d) a recording device coupled to the second electronic device for audio recording into an utterance data store (col. 4, ll. 3-4, allowing user to save any other customized message in the memory);

(e) a switchable audio input adapted to allow a user to voice directly into the second electronic device when appropriate (col. 3, ll. 29-36, different ways of getting into active communication state to converse).

Bremer does not teach of text-to-speech conversion and a telephone-to-user connection.

However, in the field of silent communication, Brunet teaches of an arrangement, to connect a user's unit (Fig. 1, item 10) with a keyboard and text-to-speech and

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speech-to-text capability (Fig. 14, item 14, 46) connecting to the telephone (Fig. 1, item 22) wherein the user listens through telephone earphone and converses by sending text messages that are converted to voice by text-to-speech converter (col. 2, ll. 23-40; col. col. 3, ll. 59-col. 4, ll. 7).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Bremer to convert text to speech and also allow telephone to user connection as taught by Brunet in order to provide an arrangement "wherein the user can communicate without disturbing others who are nearby" and "that can be used by the hearing impaired without involving a third party human transcriber" (Brunet, col. 1, ll. 60-64).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. 6,301,338	Makela
US Patent No. 6,356,634	Noble
US Patent No. 6,768,789	Wilk
US Patent Application Publication No. 2002/0181671	Logan

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

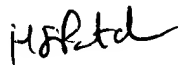
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hemant Patel whose telephone number is 571-272-8620. The examiner can normally be reached on 8:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hemant Patel
Examiner
Art Unit 2614

HSP



FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600